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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/591,464 06/09/00 HALE

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EXAMINER

WRIGHT, S

ART UNIT

PAPER NUMBER

1626

DATE MAILED:

05/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p>09/591,464</p>	<p>Applicant(s)</p> <p>HALE ET AL</p>	
	<p>Examiner</p> <p>Sonya Wright</p>	<p>Art Unit</p> <p>1626</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 in part and 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 4 and 21 is/are rejected.
- 7) ☐ Claim(s) 1-3, 5-20, and 22 is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> | 20) <input type="checkbox"/> Other: |

DETAILED ACTION

Claims 1-27 are pending in this application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-22 drawn to compounds of formula I, (variously classified in 544, 546, 549, etc.)

Group II. Claims 23-27 drawn to compounds of formula I (variously classified in 544, 548, 549, etc.)

The above groups are identified as general areas. Accordingly, as groups they are independent or distinct. Not to restrict the application would impose a severe burden on the examination of this application.

The above groups themselves are inclusive of patentably distinct subject matter. Accordingly, along with the election of one of the above groups the following action is also taken.

Claims 1-27 are generic to a plurality of disclosed patentably distinct species comprising for example, the compound designated as (1) Compound 10, page 32 (2) Compound 59, page 37 (3) Compound 201, page 39, etc. . . Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

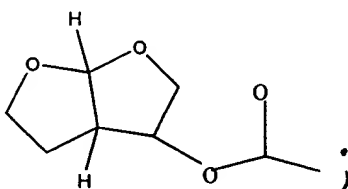
Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Upon the election of a single disclosed species, a generic concept inclusive of the elected species will be identified by the examiner for examination along with the elected species.

In response to the restriction requirement applicants attorney, Mrs. Lisa Dixon, has elected Group I, claims 1-22, and the species of compound 59, page 37, with traverse via telephone on May 9, 2001.

The following generic concept as depicted in formula (I) of claim 1 is identified for examination along with the elected embodiment, wherein A is



in (G)_x, x is 1 and G is selected from H, R⁷ or C₁-C₄ alkyl (in all other instances, x is as defined); D is -C₁-C₆ alkyl-C₃-C₆cycloalkyl-, wherein the cycloalkyl portion is optionally substituted as defined; D', E, n, R¹-R⁹, R³³, Q, M, M', W, X, Y, Z are as defined, and n, R¹-R⁹, Q, M, M', W, X, Y, Y', Z are commensurate in scope with the elected embodiment for A (see the structure for A above), D, and G. The remaining subject matter of claims 1-22 and the subject matter of claims 23-27 stands withdrawn from

Art Unit: 1626

further consideration under 37 CFR 1.142(b) as constituting other patentably distinct inventions.

The withdrawn subject matter of claims 1-22 properly restricted as said subject matter differs in structure and element from the elected subject matter so as to be patentably distinct therefrom, i.e. a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

Accordingly, the claims are drawn to more than a single invention and restriction as has been required is proper 37 CFR 1.142 (a).

Claims 1-22 are objected to as containing non-elected subject matter. This objection may be overcome by limiting the claims to the elected subject matter identified supra.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, page 376, between the last two depicted structures, insert --or--, and after the last structure, insert --.--.

Regarding claim 21, the phrase "such as" renders the claim indefinite on page 383, lines 11, 13, 15, 18, 21, 25, and on page 384, lines 1, 4, 5, 6, 8, 13, 15, and 18,

Art Unit: 1626

because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright, whose telephone number is (703) 308-4539. The examiner can normally be reached on Monday-Thursday from 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Art Unit: 1626

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.

JANE C. OSWECKI
PRIMARY EXAMINER



Joseph K. McKane

Supervisory Patent Examiner

Group 1600

Sonya Wright

May 18, 2001